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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/750,397  | 12/31/2003  | John P. Hunter JR.   | HUNTER-FIREPROOF    | 8984             |
| 4988  | 7590        | 08/08/2005           | EXAMINER            |                  |
| ALFRED M. WALKER<br>225 OLD COUNTRY ROAD<br>MELVILLE, NY 11747-2712 |             |                      | NGUYEN, CHI Q       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3635                |                  |
| DATE MAILED: 08/08/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/750,397

**Applicant(s)**

HUNTER, JOHN P.

**Examiner**

Chi Q. Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is in response to the applicant's continued application filed on 12/31/2003.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121.

I. Claims 1-8, and 18-27 (renumbered as 15-24), drawn to an apparatus of roofing layers, classified in class 52, subclass 408.

II. Claim 12 (renumbered as 9), drawn to method of forming a layered roofing system, classified in class 52, subclass 746.11.

III. Claims 13-17 (renumbered as 10-14), drawn to method of installing fire resistant roofing tiles, classified in class 52, subclass 741.4.

The inventions I and II are related as process of making and product made. The inventions are distinct if either of the following can be shown:

(1) that the process as claimed can be used to make other and materially different product or

(2) that the product as claimed can be made by another and materially different process.

For instant case, the apparatus claims could be made by a method different than that group II such as applying a layer of shingle onto a roofing deck by fastening means.

The inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or

(2) the product as claimed can be used in a materially different process of using that product (MPEP & 806.05 (h)).

In the instant case, the product claims could be utilized by applying a shingles layer on the roofing deck.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

A telephone call was made to Mr. Walker Alfred on 7/20/2005 to request an oral election and the election was elected to group III (claims 13-17) without traverse. Thus claims 1-8, 12, and 18-27 are drawn to non-elective claims.

### ***Specification***

The disclosure is objected to because of the following informalities: on page 7, line 28; the phrase "glob" appears to be a typographical error.

Appropriate correction is required.

The disclosure is objected to because of the following informalities: the applicant is advised to remove the claimed texts on page 9, lines 31-34 of the disclosure.

Appropriate correction is required.

### ***Claim Objections***

Claims 13-17 are objected to because of the following informalities: there are no such claims 9-11; therefore the claims 13-17 should be renumbered.

Accordingly, misnumbered claims 12-27 been renumbered 9-24.

Claim 15 is objected to because of it's depending upon non-elective claim 1.

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Renumbered claims 10-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S.

Patent No. 6,581,348 in view of Butler (US 4,739,603).

In regard claim 10, the patented claim 1 teaches a method of installing roofing tiles (columns 3-4) except for the patented claim 1 does not specifically teach each said tile panel having a respective fire resistant layer adhered thereto. Butler teaches simulated thatched roof including an outer covering layer coated with a fire retardant agent (col. 10, lines 25, 42-44). At the time of the invention, it would have been obvious to one having ordinary skill in the art to combine the patented claimed invention with Butler for coating a fire resistant onto the roofing structure as taught by the applicant's instant claim. The motivation for doing so would have been to retard fire and protect building structures from fire damage. And the instant claims 11-14 are corresponding to the patented claims 2-5.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DeFord (US 2003/0089061), Morrison (US 4,745,032), Ferm (US

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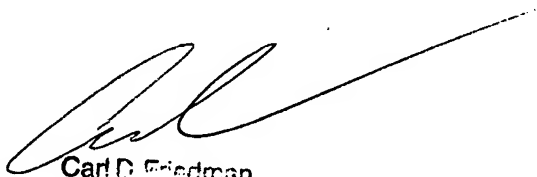
4,786,543), and Richards (US 5,037,685) teach roofing structure with fire resistant material.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847, Mon-Thu (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be reached at (571) 272-6842. The examiner's right fax number is (571) 273-6847.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairdirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

7/20/2005

  
CQN

  
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